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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209

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EXAMINER
HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
1722	10

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-10

Office Action Summary	Applicati n No.	Applicant(s)	
	09/592,284	SMOLAREK, FRANCOIS	
	Examiner	Art Unit	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *the amendment filed on March 4, 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speer et al. (US Pat. No. 5,067,887; previously of record) in view of Loedding (US Pat. No. 2,942,298).

Speer teaches a mold for manufacturing a stick (S), wherein the mold has a continuous inner surface (24) and a side wall (22) which includes a zone of weakness, which comprises a notch

(28) for facilitating radial deformation thereof (col. 3, lns. 44-47). Speer further teaches the mold to comprise a flange (16) surrounding an opening in the mold. Speer also teaches the notch to extend over substantially an entire height of the mold all the way to a bottom end of the mold (see fig. 1).

Speer fails to teach the mold to comprise a plurality of notches, or the notches to have a rounded bottom.

Loedding teaches a mold comprising a plurality of notches (38) with rounded bottoms on the side walls of the mold, the notches facilitating removal of the molded product (col. 1, lns. 56-65).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Speer as such to have provided the apparatus with a plurality of notches because this would have allowed for increased radial deformation of the sides of the mold thereby making product removal easier as suggested by Loedding.

Further, the duplication of a known part for a multiplied effect has no patentable significance unless it can be shown that there is a new and unexpected result. In re Harza, 274 F.2d 669, 124 USPQ 378 (Cust. & Pat. App. 1960); St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 193 USPQ 8 (7th Cir. 1977). In the instant case, it would be obvious to one of ordinary skill

in the art at the time of the Applicants invention to provide a plurality of notches because this would have increased the ability of the mold to be radially deformed, which would then allow the molded product to be more easily released.

It also would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Speer as such to have the notches have rounded bottoms because this is a suitable shape to facilitate the bending of the notches, thereby allowing for the removal of the product as suggested by Loedding.

The size of the various features of the apparatus including the side wall and depth of the notches, as well as the number of notches are all cause-effective variables dependent on the use of the apparatus. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). Further, the determination of the optimum value of a result effective variable is ordinarily within the skill of an ordinary artisan absent a showing of a new and unexpected result. In re Boesch, 617 F.2d 272, 205 USPQ 215 (Cust. & Pat.

App. 1980); In re Antonie, 559 F.2d 618, 195 USPQ 6 (Cust. & Pat. App. 1977); In re Aller, 220 F.2d 454, 105 USPQ 233 (Cust. & Pat. App. 1955). In the instant case, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Speer and Loedding as such to have modified size and number of notches, as well as the size of the side wall, because this would have allowed for different products with different sizes and different properties to have been molded optimally with the apparatus.

Similarly, the shape of the cavity is a cause effective variable that is dependent on the desired shape of the final product, and thus the use of the apparatus. As such, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Speer and Loedding to have the mold cavity comprise multiple conic sections, or to comprise a sloping bottom wall because these shapes would in turn allow for a conical or sloping shape to be imparted upon the final molded product made in the apparatus. Further, such a change in the cavity is in essence a change in shape of the molding apparatus. Generally changes in the shape of a known apparatus are seen as obvious modifications to one of ordinary skill in the art unless it can be shown that

there is a new, and unexpected result. In re Dailey, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (Cust. & Pat. App. 1966).

4. Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Donald Heckenberg
May 10, 2002

JAN H. SILBAUGH
SUPERVISORY PATENT EXAMINER
ART UNIT 1722
05/16/02